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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 10/773,814            | 02/06/2004  | Lukas Eisermann      | 31132.42            | 8262             |
| 46333                 | 7590        | 06/28/2007           | EXAMINER            |                  |
| HAYNES AND BOONE, LLP |             |                      | PREBILIC, PAUL B    |                  |
| 901 MAIN ST           |             |                      | ART UNIT            | PAPER NUMBER     |
| SUITE 3100            |             |                      | 3738                |                  |
| DALLAS, TX 75202      |             |                      |                     |                  |

  

|            |               |
|------------|---------------|
| MAIL DATE  | DELIVERY MODE |
| 06/28/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/773,814             | EISERMANN ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Paul B. Prebilic       | 3738                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 16 April 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 25-40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 24-28,35-40 and 42-45 is/are allowed.
- 6) Claim(s) 29-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/16/07.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 29 is rejected under 35 U.S.C. 102(e) as being anticipated by Huppert et al (US 2005/0065611). Huppert anticipates the claim language where the motion preserving implant is clearly implanted between vertebrae using a transforaminal slot as claimed; see Figures 1 to 4 and paragraphs [0036] to [0040].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huppert et al (US 2005/0065611) in view of Michelson (US 6,224,607). Huppert meets the claim language as explained *supra* but fails to disclose a step of using a cutting guide as claimed. However, since Huppert's device needs a slot (311) to insert each wing (2, 2') (see Figures 3 and 4), there is obviously a need to form a slot in each vertebra. Michelson teaches that it was known to use guides to

guide milling bits in making quadrilateral implantation slots; see the abstract, Figures 16-18, and column 12, line 11 et seq. Therefore, it is the Examiner's position that it would have been considered *prima facie* obvious to an ordinary artisan to utilize a milling bit and guide to cut the slot of Huppert for the same reasons Michelson utilizes the same or in order to ensure a straight accurately formed slot in the bone.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huppert et al and Michelson as applied to claims 30, 31, and 33 above, and further in view of Fuss et al (US 2002/0022886). Huppert as modified by Michelson, fails to disclose insertion of the implant with an insertion instrument as claimed. However, Fuss teaches that it was known to insert similar implants with insertion instruments; see Figure 6 and paragraphs [0039] and [0040]. Therefore, it is the Examiner's position that it would have been considered obvious to an ordinary artisan to utilize an insertion instrument to insert the Huppert implant for the same reasons as Fuss or to enable making as small an incision as possible.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huppert et al and Michelson as applied to claims 30, 31, and 33 above, and further in view of Geremakis et al (US 2004/0167626). Huppert discloses a partially spherical bearing surface but not a ball and socket union as required. However, Geremakis teaches that it was known to utilize a ball and socket union in similar implants within the art; see Figure 1. Therefore, it is the Examiner's position that it would have been obvious to utilize a ball and socket union in the Huppert device for the same reasons that Geremakis utilizes the same.

***Allowable Subject Matter***

Claims 25-28, 35-40, and 42-45 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments with respect to the previous rejections have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending

claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 3738